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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,881	02/06/2004	Allan L. Green	5051.002	7459

7590 05/02/2006

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/773,881	GREEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Amanda F. Wieker	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required if the application is allowed.
2. The drawings were received on 3/17/06. These drawings are approved.

### *Specification*

3. The abstract of the disclosure is objected to because it exceeds the length limit of 150 words. Correction is required. See MPEP § 608.01(b).
4. The amendment filed on 17 March 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The subject matter added to claim 10 that requires: the sole plate conform to "the entire bottom of the patient's foot"; the toe dividers be "generally thin width" and include a "cushioned tab" constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

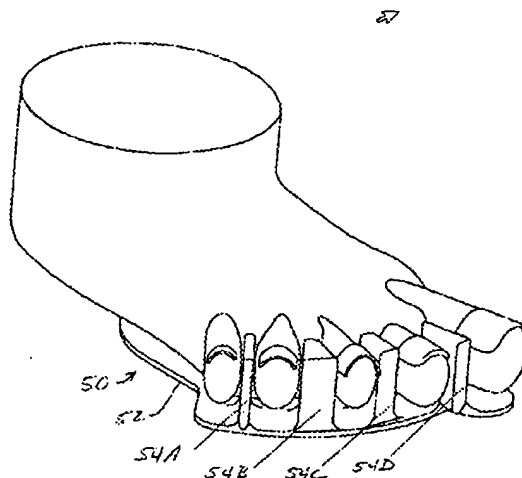
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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 10, Applicant added the following limitations that are not supported by the Specification as originally filed.

- The sole plate conforms to “the entire bottom of the patient’s foot”. This is not disclosed in the originally filed specification, with respect to the embodiment elected by original presentation (i.e., Figures 9-13). As clearly shown in the Figures, sole plate (52, 62) only extends partially along the bottom of the patient’s foot, to approximately the arch of the foot. See Figures 9, 10 and 11, specifically. The newly added limitation constitutes new matter.
- The toe dividers are “generally thin in width”. The originally filed specification did not disclose this characteristic of the invention, which appears contrary to the disclosure provided in the originally filed Drawings.



The examiner would disagree that the Figures show a “generally thin width”, as evidenced by the Figure shown above, which shows the toe divider (54b) having a width approximately equal to that of the toe. The newly added limitation constitutes new matter.

- The toe dividers include a rearwardly projecting “cushioned tab”. The originally filed specification did not disclose that the rearwardly projecting tabs (66a-d) are cushioned. See page 7. The specification provides not support for this newly added limitation, and as such, it constitutes new matter.

#### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 10-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Design Patent Number 162,870 to Pearce in view of U.S. Patent Number 6,298,580 to Tadayon.

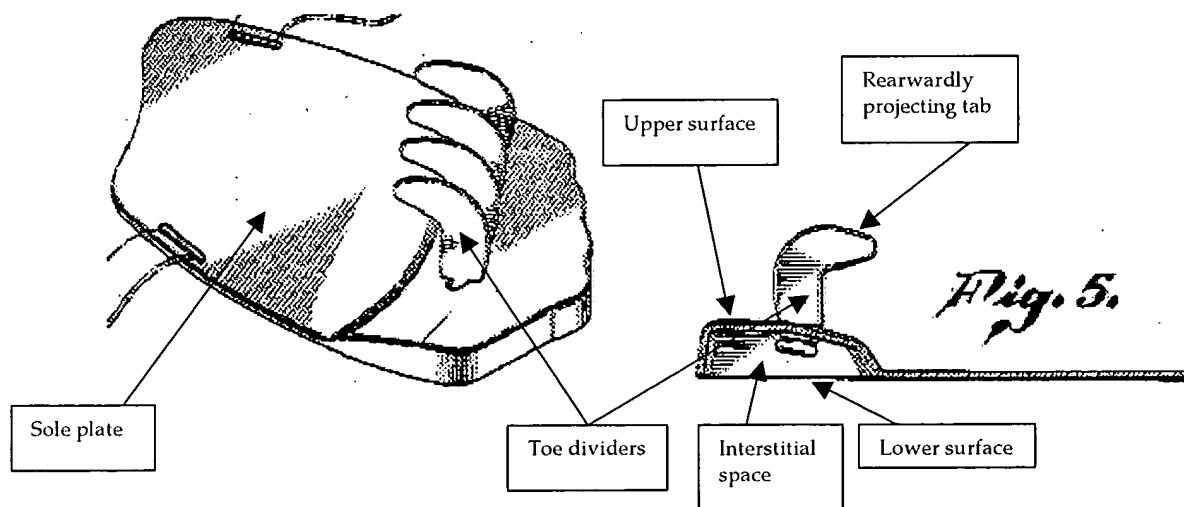
Pearce discloses a toe separator to be worn on the foot of a patient, and capable of being worn while wearing a shoe, the toe separator comprising:

a sole plate sized and shaped to conform to the bottom of a patient's foot;

said sole plate having a front edge including four upwardly projecting, generally thin in width toe dividers; and

each of said toe dividers including a rearwardly projecting tab for covering the top of the patient's foot, said cushioned tab having a thin vertical profile (see Figure 4).

The sole plate comprises a double wall structure having upper and lower surfaces/walls in spaced relation defining an interstitial space.



Pearce discloses the previously described toe separator comprising a sole plate and four upwardly projecting toe dividers. Pearce does not specify the material of the sole or toe dividers.

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Tadayon discloses a toe separator comprising a sole plate that extends along the entire bottom of the foot, and four upwardly projecting toe dividers. Tadayon specifies that the material of the sole and toe dividers be foam, to cushion the entire foot and make the toe separator comfortable to wear.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the toe separator disclosed by Pearce, wherein the sole extends along the entire foot, and wherein the sole and toe dividers are made of foam, as taught by Tadayon, to cushion the entire foot and make the toe separator comfortable to wear.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce in view of Tadayon, and in view of U.S. Patent Number 4,877,018 to Ikebe et al.

Pearce in view of Tadayon disclose the previously described toe separator comprising a sole plate and four upwardly projecting toe dividers. Pearce does not specify that the toe dividers include medicated powder.

Ikebe et al. disclose a toe separator comprising four upwardly projecting toe dividers. Ikebe et al. specify that it is well known in the art to provide medicated powder to toe dividers, to deodorize and dry the area between the toes (col. 1, lines 13-26).

It would have been obvious to one skilled in the art at the time the invention was made to have provided the toe separator disclosed by Pearce in view of Tadayon, wherein the toe dividers include medicated powder, as taught by Ikebe et al., to deodorize and dry the area between the toes.

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10. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce in view of Tadayon, and in view of U.S. Patent Application Number 2005/0034335 to Shows.

Pearce in view of Tadayon disclose the previously described toe separator comprising a sole plate and four upwardly projecting toe dividers. Pearce shows that the sole plate comprises a double wall structure having upper and lower walls in spaced relation defining an interstitial space. Pearce does not specify the material included in the interstitial space of the sole.

Shows discloses a sole plate sized and shaped to conform to the sole of a human foot. Shows specifies that the sole plate comprise upper and lower walls in spaced relation defining an interstitial space, wherein gel or water (liquid) is contained within the interstitial space to provide pain relief and warming or cooling to the sole of the user.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the toe separator disclosed by Pearce in view of Tadayon, wherein the interstitial space of the sole plate includes gel or water, as taught by Shows, to provide pain relief and warming or cooling to the sole of the user.

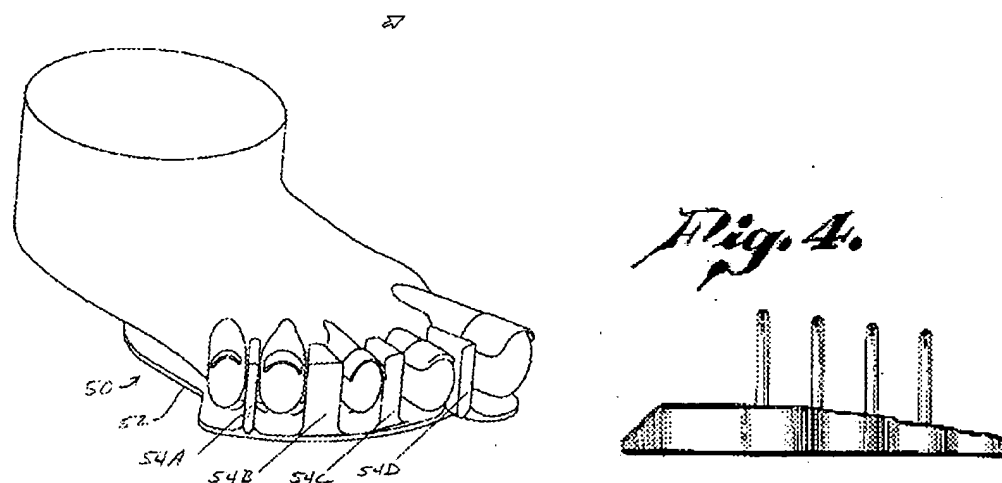
#### *Response to Arguments*

11. Applicant's arguments filed 17 March 2006 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 10-18 have been considered but are moot in view of the new ground(s) of rejection.

12. On page 7 of the Remarks, Applicant argues that Pearce does not disclose a cushioned sole plate, toe dividers or covering tabs and does not disclose a device that conforms to the entire bottom of the foot.



Pearce discloses a sole plate, toe dividers and covering tabs, but does not specify the material that makes up these elements. As noted above, Tadayon is cited as teaching a device that conforms to the entire bottom of the foot, a cushioned sole plate and cushioned toe dividers, to cushion the entire foot and make the toe separator comfortable to wear. Applicant argues that Tadayon teaches away from Applicant's thin width dividers. The Tadayon reference is cited for its teaching of a foam sole plate and toe dividers, not for any teaching regarding a width of the toe dividers. The primary reference, Pearce, clearly discloses thin width toe dividers, especially compared to Applicant's claimed "thin width" toe dividers. See below.



Clearly, Pearce discloses toe dividers that are at least as "thin" as Applicant's. In addition, as noted above, the limitations that the covering tabs are cushioned, that the toe dividers are of "thin width", and that the sole plate conforms to the entirety of the bottom of the foot, constitute new matter.

13. On page 7, Applicant also argues that Pearce discloses toe dividers that have a large vertical profile. Applicant has not identified an axis by which to measure the "vertical profile".

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As such, as seen in Figure 4, Pearce discloses toe dividers with covering tabs that have a thin vertical profile.

14. On page 8, Applicant argues that there is no teaching of incorporating the medicated powder taught by Ikebe et al. into an apparatus as claimed.

The examiner disagrees. Ikebe et al. disclose a toe separator comprising four upwardly projecting toe dividers. Ikebe et al. specify that it is well known in the art to provide medicated powder to toe dividers, to deodorize and dry the area between the toes (col. 1, lines 13-26). The examiner maintains that based on this teaching, it would have been obvious to have provided the toe separator disclosed by Pearce in view of Tadayon, wherein the toe dividers include medicated powder, as taught by Ikebe et al., to deodorize and dry the area between the toes.

These references are all from the same field of endeavor and attempt to solve the same problem.

15. On page 8, Applicant argues that there is no teaching of combining the sole insert taught by Shows into an apparatus with a toe dividing structure as claimed.

The examiner disagrees. Pearce shows that the sole plate comprises a double wall structure having upper and lower walls in spaced relation defining an interstitial space. Pearce does not specify the material included in the interstitial space of the sole. Shows discloses a sole plate sized and shaped to conform to the sole of a human foot. Shows specifies that the sole plate comprise upper and lower walls in spaced relation defining an interstitial space, wherein gel or water (liquid) is contained within the interstitial space to provide pain relief and warming or cooling to the sole of the user. The examiner maintains that in light of the interstitial space

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disclosed by Pearce, and with the teachings of Shows, it would have been obvious to one skilled in the art at the time the invention was made to have provided the toe separator disclosed by Pearce in view of Tadayon, wherein the interstitial space disclosed by Pearce includes gel or water, as taught by Shows, to provide pain relief and warming or cooling to the sole of the user.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has identified such motivation as noted above.

### *Conclusion*

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

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37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
afw

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